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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/753,465 | 01/09/2004 | Yao-Ming Wang | 3313-1092P | 6419 |

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| EXAMINER | |
|---|---|
| SCHNEIDER, JOSHUA D | |
| **ART UNIT** | **PAPER NUMBER** |
| 2182 | |

DATE MAILED: 02/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/753,465 | WANG ET AL. | |
| | Examiner | Art Unit | |
| | Joshua D. Schneider | 2182 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *09 January 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *1/9/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 3 and 10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not teach the IO card and the memory card share all of the data buses of the IO card to transmit data with the host system when the memory card is connected to the first data bus to transmit data (does not share the control data busses).

3. All further rejections and objections are made in view of the specification as best understood in light of the previous objections and rejections.

### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) in further view of U.S. Patent 6,983,281 to Utsumi.

6. With regards to claims 1 and 8, the AAPA teaches inserting the memory card in the IO card (page 2, lines 17-22); connecting the IO card to the host system (page 2, lines 17-22); but fails to teach generating a bus control signal through an IO controller on the IO card to switch to a first data bus or a second data bus located in the IO card thereby to change data transmitting path between the memory card and the host system. Utsumi teaches an IO card for connecting a memory card to a host (column 5, lines 31, through column 6, lines 50). Utsumi also teaches generating a bus control signal through an IO controller on the IO card to switch to a first data bus or a second data bus located in the IO card thereby to change data transmitting path between the memory card and the host system (Fig. 4, element 3d, column 11, line 38, through column 13, line 52). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the switch control of Utsumi with the memory card insertion of the AAPA in order to eliminate unnecessary processing by the IO card.

7. With regards to claims 2 and 9, the bus control signal controls a switch to switch to the first data bus or the second data bus is inherently taught by the automatic path selection of Utsumi (Fig. 4, element 3d, column 11, line 38, through column 13, line 52). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the switch control of Utsumi with the memory card insertion of the AAPA in order to eliminate unnecessary processing by the IO card.

8. With regards to claims 3 and 10, Utsumi teaches the IO card and the memory card share all of the data buses of the IO card to transmit data with the host system when the memory card is connected to the first data bus to transmit data (Fig. 4, element 3d, column 11, line 38, through column 13, line 52). It would have been obvious to one of ordinary skill in the art at the time of

invention to combine the switch control of Utsumi with the memory card insertion of the AAPA in order to eliminate unnecessary processing by the IO card.

9. With regards to claims 4 and 11, Utsumi teaches the memory card and the IO card further transmit data directly via the first bus without passing through the data bus of the host system (Fig. 1, elements 11 and 52). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the switch control of Utsumi with the memory card insertion of the AAPA in order to eliminate unnecessary processing by the IO card.

10. With regards to claims 5 and 12, Utsumi teaches the memory card uses a portion of the data buses of the IO card to transmit data with the host system when the memory card is connected to the second data bus to transmit data, the IO card uses remaining data buses to transmit data with the host system (Fig. 4, elements 3d, 3b, 83, and 79, column 11, line 38, through column 13, line 52). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the switch control of Utsumi with the memory card insertion of the AAPA in order to eliminate unnecessary processing by the IO card.

11. With regards to claims 6 and 13, the AAPA teaches the IO card has a socket to electrically and mechanically couple with the memory card (page 2, line 23, through page 3, line 3).

12. With regards to claims 7 and 14, the host system has an insertion slot to electrically and mechanically couple with the IO card (page 2, line 23, through page 3, line 3).

***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent 6,381,662 to Harari et al. teaches a method of connecting a memory card

either directly to a host or through an IO card (Fig. 11). U.S. Patent Application Publication 2002/0021596 to Rolandi teaches the direct and indirect connection of a memory card to a host system (Fig. 4). U.S. Patent 4,695,895 to Nagashima teaches an IO bypass switch (Fig. 2, element A1). U.S. Patent 4,858030 to Oku et al. teaches an IO bypass switch (Fig. 1, element 5).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D. Schneider whose telephone number is (571) 272-4158. The examiner can normally be reached on M-F, 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Huynh can be reached on (571) 272-4147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JDS

KIM HUYNH
SUPERVISORY PATENT EXAMINER
2/16/05